

## REMARKS

Claims 1-29 are pending in the application. Claims 1, 10, 17, and 26 are independent. By the foregoing Amendment, claims 1, 10, 17, and 26 have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

### Rejection of Claims 1-9 and 26-29 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 1-9 and 26-29 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,529,801 to Rosenblum (hereinafter “*Rosenblum*”). A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Applicant respectfully traverses the rejection.

Embodiments of the present invention are directed to a real-time prescription transaction and adjudication across a network. Independent claim 1 recites in pertinent part “forwarding the prepared results to the portable healthcare device to be considered in generating a prescription for transfer in real-time across a network pathway to a remote prescription site; and ***comparing the prescription with the prepared results*** to determine whether the prescription is in compliance with the prepared results” (emphasis added). Independent claim 26 recites in pertinent part “forwarding the prepared results to the portable healthcare device to be considered in generating a prescription; and receiving the prescription from the portable healthcare device, ***comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results***, and transferring the prescription across the network pathway in real-time to the remote prescription site” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicant’s Specification at paragraph [0066].

In the Office Action, the Examiner states that *Rosenblum* teaches receiving a prescription proposal from a portable healthcare device for real-time adjudication, transmitting the prescription proposal to a benefits manager for immediate adjudication of the prescription

proposal, preparing results of the adjudication from the benefits manager for reading at the portable healthcare device, and forwarding the prepared results to the portable healthcare device to be considered in generating a prescription for transfer in real-time across a network pathway to a remote prescription site. Applicant respectfully disagrees.

Applicant respectfully submits that *Rosenblum* fails to teach the identical invention as independent claims 1 and/or 26. For example, *Rosenblum* fails to teach comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results, as recited in claims 1 and 26. *Rosenblum* therefore fails to teach the identical invention of claims 1 and/or 26 and thus fails to anticipate claims 1 and/or 26.

Claims 2-9 properly depend from claim 1, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 2-9 are patentable for at least the same reasons that claim 1 is patentable. Claims 27-29 properly depend from claim 26, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 27-29 are patentable for at least the same reasons that claim 26 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-9 and 26-29.

#### Rejection of Claims 10-25 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 10-25 under 35 U.S.C. §103(a) as being obvious in view of *Rosenblum*. To establish a *prima facie* case of obviousness, an Examiner must show that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Applicant respectfully traverses the rejection.

Independent claim 10 recites in pertinent part “*an interface to prepare the prescription for receipt by a next segment in the network pathway towards a remote prescription site, wherein the*

interface is further to compare the prescription with the adjudication results to *determine whether the prescription is in compliance with the adjudication results*” (emphasis added). Independent claim 17 recites in pertinent part ““forwarding the prepared results to the portable healthcare device to be considered in generating a prescription for transfer in real-time across a network pathway to a remote prescription site; and *comparing the prescription with the prepared results* to determine whether the prescription is in compliance with the prepared results” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicant’s Specification at paragraph [0066].

In the Office Action, the Examiner states that the system claims of claims 10-16 would have been obvious in order to implement method claims 1-3 and 5-8 and rejected claims 10-16 under the same rationale as claims 1-3 and 5-8. Applicant respectfully disagrees.

Applicant respectfully submits that *Rosenblum* fails to teach the identical invention as independent claims 10 and/or 17. For example, *Rosenblum* fails to teach comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results, as recited in claims 10 and 17. *Rosenblum* therefore fails to teach the identical invention of claims 10 and/or 17 and thus fails to anticipate claims 10 and/or 17.

Claims 11-16 properly depend from claim 10, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 11-16 are patentable for at least the same reasons that claim 1 is patentable. Claims 18-25 properly depend from claim 17, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 18-25 are patentable for at least the same reasons that claim 17 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 10-25.

### CONCLUSION

Applicant submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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